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09/940,783	08/28/2001	Brian J. Petryna	PETRYNA 8	3916

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EXAMINER
LEE, ANDREW CHUNG CHEUNG

ART UNIT	PAPER NUMBER
2419	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	09/940,783	PETRYNA, BRIAN J.
	Examiner	Art Unit	
	Andrew C. Lee	2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
> - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>20 October 2008</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Claims 1 – 21 are pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.   Claims 1, 8, 15, 2, 9, 16, 7, 14, 21 are rejected under 35 U.S.C. 102(e) as being

anticipated by Petras et al. (6215784 B1).

Regarding claims 1, 8, 15, Petras et al. disclose a system, method, computer

for automatically initiating a subsequent telephone call over a computer network from a

second caller to a first caller *(Fig. 1, Fig 3, "a user of a first voice terminal and a*

computing machine connected to a data network to compete a voice connection ...."

interpreted as automatically initiating a subsequent telephone call over a computer

network from a second caller to a first caller; Fig. 1, Fig. 3, col. 1, lines 66 – 67, col. 2,

lines 1 – 4), comprising: an address interceptor *("computer-controlled telephony*

integration (CTI) server and hardware" interpreted as an address interceptor; Fig. 1,

Fig. 3, elements 40, 44), associated with a station of a circuit-switched telephone

network, that receives calling number identification signals of said first caller from a first

telephone call from said first caller to said second caller over said circuit-switched

telephone network *(Fig. 3, "the off-hook condition……PBX is programmed to*

automatically dial a number assigned to the CTI hardware…." Interpreted as to

receives calling number identification signals of said first caller from a first telephone

call from said first caller to said second caller over said circuit-switched telephone

network; col. 7, lines 9 – 16) and extracts from said calling number identification signals

a destination address of said first caller for said subsequent telephone call from said

second caller to said first caller *("CTI server extracts the telephone number ….Calling*

Line Identification.." interpreted as extracts from said calling number identification

signals a destination address of said first caller; col. 7, lines 16 – 40, col. 8, lines 31 –

41); a network call initiator *("warm line server" interpreted as a network call initiator;*

Fig. 3, element 38), coupled to said address interceptor and associated with a

computer network terminal *(Fig. 3)* that employs said destination address of said first

caller to automatically initiate said subsequent telephone call to said destination

address via said computer network terminal *(Fig. 3, col. 8, lines 31 – 52)*.

Regarding claims 2, 9, 16, Petras et al. disclose a system, method, computer as

recited in claimed wherein said calling number identification signals and said destination

address are associated with a single location *("Automatic Number Identification (ANI)*

information ..and IP address .." interpreted as said calling number identification signals

and said IP address .." interpreted as said calling number identification signals

and said said IP address are associated with a single location; Abstract, col. 7, lines

16 – 35).

Regarding claims 7, 14, 21, Petras et al. disclose a system, method, computer

as recited in claimed wherein said station and said computer network terminal are

embodied in a computer and wherein a single telephone line alternatively couples said

station to said circuit-switched telephone network (*Fig. 1, elements 34, 36; col. 5, lines*

14 – 21) and said computer network terminal to said computer network (*Fig. 3, elements*

18, 20; col. 5, lines 1 – 14).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Scott et al. (US 6760324 B1) in view of Petras et al. et al. (6215784 B1).

Regarding claims 1, 8, 15, Scott et al. disclose a system, method, computer for

automatically initiating a telephone call over a computer network from a second caller

to a first caller *("allows traffic originating on a circuit-switched network to be carried*

over a packet-switched network" correlates to initiating a telephone call over a

computer network; col. 6, lines 24 – 37, Abstract, lines 1 – 6; Fig. 2, elements 202, 205,

207, 210, 215, 220, 205, 291), comprising: an address interceptor, associated with a

station of a circuit-switched telephone network *("Gateway server performing bridging of*

calls between the traditional telecommunication network and IP network, and to

translate numbers and routing those numbers to the correct destination gateway"

correlates to an address interceptor, associated with a station of a circuit-switched

telephone network; Fig. 2, elements 220, 210, gateway server, column 8, lines 37 – 55;

element 291, 292 "an ordinary telephone coupling to PSTN"; element 205, "PSTN";

column 11, lines 45 – 55), that receives calling number identification signals of said first

caller from a first telephone call from said first caller to said second caller over said

circuit-switched telephone network via a first telephone call *("ANI information or caller*

ID information" correlates to receives calling number identification signals from said

circuit-switched telephone network via a first telephone call; col. 53, lines 51 – 58, col.

61, lines 1 – 8, col. 6, lines 24 – 37); and,

    Scott et al. also disclose a network call initiator *(interpreted as routing server)*,

coupled to said address interceptor and associated with a computer network terminal

that employs said destination address of said first caller to automatically initiate said

subsequent telephone call to said destination address via said computer network

terminal *("all routes to be configured on the routing server, but automatically distributed*

to the appropriate gateways and can be also distribute E.164 translation data"

correlates to associated with a computer network terminal that employs said

destination address of said first caller to automatically initiate said subsequent

telephone call to said destination address via said computer network terminal; Fig. 3B,

col. 8, lines 60 – 64; element "routing server"; col. 9, lines 1 – 12; col. 59, lines 60 – 65;

col. 61, lines 41 – 45; lines 17 – 19; lines 25 – 55; col. 70, lines 15 – 35).

Scott et al. do not disclose explicitly extracts from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller.

Petras et al. teach the limitation of extract from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller (*"CTI server extracts the telephone number ......*

....Calling Line Identification.." interpreted as extracts from said calling number identification signals a destination address of said first caller; col. 7, lines 16 – 40, col. 8, lines 31 – 41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Scott et al. to include the features of extract from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller as taught by Petras et al. in order to provide a user of a first voice terminal and a computing machine connected to a data network to complete a voice connection with a second voice terminal for which information for directly or indirectly identifying the second voice terminal is available in an open application on the computing machine (*as suggested by Petras et al., see col. 1, lines 66 – 67, col. 2, lines 1 – 4*).

Regarding claims 2, 9, 16, Scott et al. disclose a system, method, computer as recited in claimed wherein said calling number identification signals and said destination address are associated with a single location (*"caller ID information" correlates to said calling number identification signals, and "Destination Number type*

and Destination number Plan" correlates to destination address are associated with a

single location; col. 53, lines 51 – 58; col. 61, lines 1 – 9).

      Regarding claims 3, 10, 17, Scott et al. disclose a system, method, computer as

recited in claimed wherein said destination address is selected from the group

consisting of: a telephone number *(col. 69, lines 37 – 41; col. 70, lines 2 – 8),* an

Internet Protocol address *(col. 39, lines 16 – 17),* a Voice over Internet Protocol (VoIP)

gateway address *(col. 11, line 52; col. 74, lines 3 – 5),* and a VoIP gateway address

combined with a telephone number *(col. 73, lines 41 – 56; lines 66 – 67; col. 74, lines 1*

– 5).

      Regarding claims 4, 11, 18, Scott et al. disclose a system, method, computer as

recited in claimed wherein said computer network is the Internet *(Fig. 1B, element 120;*

Fig. 2, element 215; col. 1, lines 56 – 57).

      Regarding claims 5, 12, 19, Scott et al. disclose the limitation of a system,

method, computer as recited in claimed wherein said station leaves unanswered a call

transmitting said calling number identification signals *(col. 53, lines 43 – 47; lines 51 –*

58, elements Unanswered Rings, Caller ID information can be associated with each port

of the MSI/SC).

      Regarding claims 6, 13, 20, Scott et al. disclose the limitation of a system,

method, computer as recited in claimed wherein said calling number identification

signals are associated with a second station, said second station hanging up after a

predetermined number of unanswered rings *(col. 50, lines 38 – 40, lines 43 – 46; "wait*

for maximum number of rings on the outbound call before it gives up, outbound call"

correlates to the second station hanging up after a predetermined number of

unanswered rings; col. 53, lines 43 – 47).

     Regarding claims 7, 14, 21, Scott et al. disclose the limitation of a system,

method, computer as recited in claimed wherein said station and said computer network

terminal are embodied in a computer (Fig. 2, elements 210, 220; col. 6, lines 38 – 42)

and wherein a single telephone line alternatively couples said station to said circuit-

switched telephone network (Fig. 2, elements 201, 202, 205; col. 6, lines 30 – 36) and

said computer network terminal to said computer network (Fig. 2, elements 293, 215;

col. 4, lines 9 – 17, personal computers, to be on the same local area network (LAN) as

long as they are connected via an IP network).

6.   Claims 1 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Scott et al. (US 6760324 B1) in view of Blair (US 7110395 B1).

     Regarding claims 1, 8, 15, Scott et al. disclose a system, method, computer for

automatically initiating a telephone call over a computer network from a second caller

to a first caller *("allows traffic originating on a circuit-switched network to be carried*

over a packet-switched network" interpreted as initiating a telephone call over a

computer network; col. 6, lines 24 – 37, Abstract, lines 1 – 6; Fig. 2, elements 202, 205,

207, 210, 215, 220, 205, 291), comprising: an address interceptor, associated with a

station of a circuit-switched telephone network *("Gateway server performing bridging of*

calls between the traditional telecommunication network and IP network, and to

translate numbers and routing those numbers to the correct destination gateway"

correlates to an address interceptor, associated with a station of a circuit-switched

telephone network; Fig. 2, elements 220, 210, gateway server, column 8, lines 37 – 55;

element 291, 292 "an ordinary telephone coupling to PSTN"; element 205, "PSTN";

column 11, lines 45 – 55), that receives calling number identification signals of said first

caller from a first telephone call from said first caller to said second caller over said

circuit-switched telephone network *("ANI information or caller ID information" correlates*

to receives calling number identification signals from said circuit-switched telephone

network via a first telephone call; col. 53, lines 51 – 58, col. 61 , lines 1 – 8); and,

Scott et al. also disclose a network call initiator *(interpreted as routing server)*,

coupled to said address interceptor and associated with a computer network terminal

that employs said destination address to automatically initiate said subsequent

telephone call to said destination address via said computer network terminal *("all*

routes to be configured on the routing server, but automatically distributed to the

appropriate gateways and can be also distribute E.164 translation data" correlates to

associated with a computer network terminal that employs said destination address to

automatically initiate said subsequent telephone call to said destination address via

said computer network terminal; Fig. 3B, col. 8, lines 60 – 64; element "routing server";

col. 9, lines 1 – 12; col. 59, lines 60 – 65; col. 61, lines 41 – 45; lines 17 – 19; lines 25 –

55; col. 70, lines 15 – 35).

Scott et al. do not disclose explicitly extracting from said calling number

identification signals a destination address of said first caller for said subsequent

telephone call from said second caller to said first caller.

Blair discloses extracting from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller *(Fig. 2, Abstract, lines 1 – 17, col. 2, lines 42 – 60).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Scott et al. to include the features of extracting from said calling number identification signals a destination address of said first caller for said subsequent telephone call from said second caller to said first caller as taught by Blair in order to provide voice over data network calling, more particularly to voice over data network calling that does not require an out of band communication to connect *(as suggested by Blair, see col. 1, lines 7 – 10).*

Regarding claims 2, 9, 16, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said calling number identification signals and said destination address are associated with a single location *("caller ID information" correlates to said calling number identification signals, and "Destination Number type and Destination number Plan" correlates to destination address are associated with a single location; col. 53, lines 51 – 58; col. 61, lines 1 – 9).*

Regarding claims 3, 10, 17, Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said destination address is selected from the group consisting of: a telephone number (col. 69, lines 37 – 41; col. 70, lines 2 – 8), an Internet Protocol address *(col. 39, lines 16 – 17),* a Voice over Internet Protocol (VoIP) gateway address *(col. 11, line 52; col. 74, lines 3 – 5),* and a VoIP gateway

address combined with a telephone number *(col. 73, lines 41 – 56; lines 66 – 67; col. 74, lines 1 – 5).*

Regarding claims **4, 11, 18,** Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said computer network is the Internet *(Fig. 1B, element 120; Fig. 2, element 215; col. 1, lines 56 – 57).*

Regarding claims **5, 12, 19,** Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said station leaves unanswered a call transmitting said calling number identification signals *(col. 53, lines 43 – 47; lines 51 – 58, elements Unanswered Rings, Caller ID information can be associated with each port of the MSI/SC).*

Regarding claims **6, 13, 20,** Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said calling number identification signals are associated with a second station, said second station hanging up after a predetermined number of unanswered rings *(col. 50, lines 38 – 40, lines 43 – 46; "wait for maximum number of rings on the outbound call before it gives up, outbound call" correlates to the second station hanging up after a predetermined number of unanswered rings; col. 53, lines 43 – 47).*

Regarding claims **7, 14, 21,** Scott et al. disclose the limitation of a system, method, computer as recited in claimed wherein said station and said computer network terminal are embodied in a computer *(Fig. 2, elements 210, 220; col. 6, lines 38 – 42)* and wherein a single telephone line alternatively couples said station to said circuit-switched telephone network *(Fig. 2, elements 201, 202, 205; col. 6, lines 30 – 36)* and

said computer network terminal to said computer network *(Fig. 2, elements 293, 215;*

col. 4, lines 9 – 17, personal computers, to be on the same local area network (LAN) as

long as they are connected via an IP network).

Response to Arguments

7.   Applicant's arguments filed on 10/20/2008 with respect to claims 1 – 21 have

been fully considered but they are not persuasive.

- Regarding rejections of Claims 1, 8, 15, 2, 9, 16, 7, 14, 21 under 35 U.S.C. 102

    (e): Reference Petras.

    Regarding claims 1, 8, 15, Applicant argues the cited portions of reference

Petras neither teach nor suggest extracting a destination address for a subsequent

telephone call from calling number identification signals received from a first telephone

call over a circuit-switched telephone network from a first caller to a second caller and

employing the destination address to automatically initiate the subsequent call to the

destination address via a computer network.

    Examiner respectfully disagrees.

    Examiner contends reference Petras teach/suggest extracting a destination

address for a subsequent telephone call from calling number identification signals

received from a first telephone call over a circuit-switched telephone network from a first

caller to a second caller and employing the destination address to automatically initiate

the subsequent call to the destination address via a computer network.

Examiner interpreted extracting a destination address for a subsequent telephone call from calling number identification signals received from a first telephone call over a circuit-switched telephone network from a first caller to a second caller as *"the off-hook condition……PBX is programmed to automatically dial a number assigned to the CTI hardware…."; see reference Petras: Fig. 3, col. 7, lines 9 – 16* and *"CTI server extracts the telephone number ….Calling Line Identification.." ; col. 7, lines 16 – 40, col. 8, lines 31 – 41*; and interpreted employs said destination address of said first caller to automatically initiate said subsequent telephone call to said destination address via said computer network terminal as "instructs the CTI hardware to dial the number 1234567 which is a number for the called party telephone, see reference Petras, *Fig. 3, col. 8, lines 31 – 52*.

Therefore reference Petras et al. does support extract from a first telephone call a destination address for a subsequent telephone call. Based upon the current interpretation of first caller and second caller, in applicant's initial specification, there is no clear defined and indicated first caller and second caller.

For the above reasons, it is strongly believed that the rejection of claims 1, 8, and 15 under 35 U.S.C. 102(e) based on reference Petras et al. should be maintained.

- Regarding rejections of Claims 1 – 21 under 35 U.S.C. 103 (a): References Scott and Petras

Applicant argues reference Petras does not teach extracting a destination address for a subsequent call over a computer network from calling number

identification signals received. As such, Petras does not cure the deficiency of Scott noted by the Examiner. Therefore, the cited combination of cited portions of Scott and Petras does not provide a *prima facie* case of obviousness for independent Claims 1,8, and 15 and Claims that depend thereon.

Examiner respectfully disagrees.

Examiner contends reference Petras et al. teach extracting a destination address for a subsequent telephone call, the subsequent telephone call initiated over a computer network from a second caller to a first caller. Examiner interpreted extracting a destination address for a subsequent telephone call, the subsequent telephone call initiated over a computer network from a second caller to a first caller as "CTI server extracts the telephone number ….Calling Line Identification.." see col. 7, lines 16 – 40, col. 8, lines 31 – 41. Therefore reference Petras et al. does support extracting a destination address for a subsequent telephone call, the subsequent telephone call initiated over a computer network from a second caller to a first caller. Based upon the current interpretation of first caller and second caller, in applicant's initial specification, there is no clear defined and indicated first caller and second caller.

- Regarding rejections of Claims 1 – 21 under 35 U.S.C. 103 (a): References Scott and Blair.

Applicant argues reference Blair, as relied upon by the Examiner, does not teach extracting a destination address for a subsequent call from a first telephone call from a first caller to a second caller as required by amended Claims 1, 8, and 15 but, rather,

from a connection to a network service provider. Thus Blair does not cure the noted
deficiencies of Scott.

Examiner respectfully disagrees.

Examiner contends reference Blair suggests extracting a destination address for
a subsequent telephone call, the subsequent telephone call initiated over a computer
network from a second caller to a first caller. Examiner interpreted extracting a
destination address for a subsequent telephone call, the subsequent telephone call
initiated over a computer network from a second caller to a first caller as "a call identifier
will be sent along with the call signal, caller ID"; see reference Blair, Abstract, and Fig.
2, col. 2, lines 42 – 60, origination phone interpreted as first caller and destination
phone interpreted as second caller.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

- a) Petras et al. (US 6215784 B1).
- b) Takahara et al. (6078583).
- c) Oran (US 6275574 B1).
- d) Mckinnon et al. (US 6175565 B1).
- e) Vander Meiden (US 6553116 B1).
- f) Hakim et al. (US 20020167943).

9.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Andrew C. Lee whose telephone number is (571) 272-

3131. The examiner can normally be reached on Monday through Friday from 8:30am -
5:00pm.

   If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for
the organization where this application or proceeding is assigned is 571-273-8300.

   Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
published applications may be obtained from either Private PAIR or Public PAIR.
Status information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov. Should
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USPTO Customer Service Representative or access to the automated information
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew C Lee/
Examiner, Art Unit 2419
<2/01/2009:2Qy09>

/Chirag G Shah/
Supervisory Patent Examiner, Art Unit 2419